

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims:

Claims 6 and 9-12 are currently being cancelled.

Claim 1-5 and 7-8 are currently being amended. Please note that independent claims 1, 7 and 8 are being amended to expedite prosecution of this application. Applicants strongly believe that original claims 1, 7 and 8 distinguish over the cited art of record, and Applicants intend to prosecute those claims, along with other claims, in a continuation patent application.

Claims 13-25 are currently being added.

This amendment and reply adds, cancels and amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After adding, canceling and amending the claims as set forth above, claims 1-5, 7-8 and 13-25 are now pending in this application.

Interview at PTO:

Applicants' representative appreciates the courtesies extended to him and his colleagues during a personal interview conducted at the PTO on August 16, 2006. During that interview, the prior art was discussed with reference to independent claims 1 and 7, whereby Applicants' argued that these claims patentably distinguish over the cited art of record.

Comments Regarding Claim 8:

Applicants note with appreciation that claim 8 is not rejected over any prior art (or any other type of rejections). The minor amendment made to claim 8 (GSM network to "GSM-type network") should not affect the allowability of that claim.

Specification Amendments:

The specification has been amended to correct minor typographical errors found therein. Please note in particular the modifications to paragraph 0003, whereby the added text and paragraphs are from the parent application 09/578,705, and whereby that text was mistakenly not included in the as-filed divisional application. No new matter has been added.

Double Patenting Rejection:

In the Office Action, claims 1-12 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,725,039. In accordance with the M.P.E.P., Applicants respectfully request deferral of this rejection until when allowable subject matter is indicated by the U.S. PTO, at which time Applicants will file a terminal disclaimer in order to overcome this rejection.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph:

In the Office Action, claims 6 and 9-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, for the reasons set forth on page 3 of the Office Action. Due to the cancellation of claims 6 and 9-12, this rejection is now moot.

Claim Rejections – Prior Art:

In the Office Action, claims 1-4, 6-7 and 9-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,377,804 to Lintulampi; and claims 5 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of U.S. Patent No. 6,556,820 to Le et al. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

Independent claim 1 and independent claim 7 recite, among other things, that the UTRAN parameters pass transparently to the User Equipment via the GSM-type network. During the interview with Examiner Le, Applicants' representatives explained that Lintulampi's system does not pass through UTRAN parameters transparently via a GSM-type network, but instead several components of Lintulampi's GSM-type network interpret and modify the handover information before passing it on to another component. See, for example, the different names assigned to handover signals as shown in Figure 4 of Lintulampi, lending credence to the fact that certain GSM-type network components in the

system of Lintulampi modify handover signals prior to passing them on to another component (in a direction of the MS).

Accordingly, presently pending independent claims 1 and 7 are patentable over Lintulampi, whereby Le et al. (cited against certain dependent claims) does not rectify the above-mentioned deficiencies of Lintulampi.

The presently pending dependent claims are patentable for the reasons given above with respect to their respective base claim, as well as for the specific features recited in those dependent claims.

New Claims:

New claims 13-25 have been added to recite additional features of the present invention that are believed to provide a patentably distinguish over the cited art of record. For example, new independent claims 17 and 23 recite that an RNC forwards UMTS parameters transparently to UE via a GSM-type network, whereby such features are not taught or suggested by Lintulampi or by Le et al., alone or in combination. New independent claim 20 recites similar features with respect to UE, whereby such features are not taught or suggested by Lintulampi or by Le et al., alone or in combination.

New dependent claims 13, 15, 18, 21 and 24 recite particular features of the UTRAN parameters that are passed, whereby such type of UTRAN parameters are not taught or suggested by Lintulampi or by Le et al. New dependent claims 14, 16, 19, 22 and 25 recite that the UTRAN parameters comprise at least one potential access node to the UE, whereby such features are not taught or suggested by Lintulampi or by Le et al.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date August 24, 2006

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